REMARKS

Upon entry of this amendment, claims 1-27 are all the claims pending in the application.

New claims 18-27 are added by this Amendment. No new matter has been added.

I. Preliminary Matters

Applicant notes that a certified foreign priority document was filed with the present

application on April 10, 2001. A copy of the USPTO mail room receipt for the priority

document is enclosed. Accordingly, Applicant respectfully requests that the Examiner

acknowledge Applicant's claim for foreign priority and confirm that the certified copy of the

priority document has been received.

Applicant also notes that the Notice of References Cited (PTO-892) submitted by the

Examiner does not list U.S. Patent No. 6,272,469 ("the '469 patent") to Koritzinsky thereon. As

the '469 patent was used by the Examiner in formulating the rejection of claims 1-17, Applicant

kindly requests that the Examiner list this reference on a PTO-892 form and submit the form

with the next Office paper.

A replacement sheet for Fig. 1 is being submitted herewith. The changes to the drawing

are as follows: In the account terminal 15, the arrows that reference characters (C) and (D) point

toward are being switched in order to be consistent with the specification. In particular, as

discussed on page 11, lines 7-13, a royalty for utilizing the design database is paid from the bank

account of the designer to the bank account of the parts vendor and an employment fee is paid

from the bank account of the parts vendor to the bank account of the designer.

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Applicant also notes that the claims have been amended for the purpose of improved

readability and clarity. Applicant submits that such amendments were not made in response to

any prior art rejection or other rejection. Such amendments do not narrow the scope of the

claims and, therefore, do not subject the claims to prosecution history estoppel.

II.   Claim Rejections under 35 U.S.C. § 102(e)

Claims 1-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Koritzinsky

(U.S. Patent No. 6,272,469). Applicant respectfully traverses this rejection on the following

basis.

Claim 1 sets forth the feature of a design database server for storing a design database

containing information on sample circuits. Applicant submits that the claimed combination,

including at least this feature, is neither disclosed nor suggested by Koritzinsky.

Koritzinsky discloses a system which provides operational protocols to users of a medical

diagnostic center (see col. 1, lines 5-7). Different protocols are provided depending on the type of

procedure that is being employed, such as an MRI scan, a CT scan or a PET scan (see col. 1, lines

53-65). The protocols are made available over a network such that users at remote locations can

download the required protocols depending on the type of system (e.g., MRI, CT, PET) that is being

used (see col. 4, lines 25-30).

The Examiner asserts that Koritzinsky discloses the feature of a design database server for

storing a design database containing information on sample circuits at col. 2, line 39 through col. 3,

line 2. Applicant respectfully disagrees.

As discussed above, Koritzinsky provides a system that enables different protocols to be accessed by remote users depending on the type of medical procedure that is being performed. In no way, however, does Koritzinsky disclose a design database server for storing a design database containing information on sample circuits, as is set forth in claim 1. Indeed, Koritzinsky does not even remotely suggest such a feature.

It appears as though the Examiner has given no patentable weight to the claimed function of the database server. Applicant submits that the feature of storing a design database containing information on sample circuits and information is a functional limitation that describes the function of the "database server" and, therefore, must be given patentable weight.

As is clearly set forth in MPEP §2173.05(g), there is nothing inherently wrong with defining some part of an invention in functional terms. "A functional limitation <u>must be evaluated and considered</u>, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." See MPEP §2173.05(g) (Emphasis added).

In addition, claim 1 sets forth the feature of a designer terminal for a designer to search said design database and conduct the design of the device. The Examiner again points to col. 2, line 39 through col. 3, line 2 of Koritzinsky as allegedly disclosing this feature of the claim. Applicant respectfully disagrees.

Applicant submits that there is no disclosure in Koritzinsky which could even remotely be interpreted as corresponding to this feature of claim 1. As discussed above, Koritzinsky

merely discloses a system which enables different protocols to be downloaded to medical

facilities.

Therefore, as Koritzinsky merely enables different protocols to be downloaded by remote

users, Applicant submits that Koritzinsky fails to disclose a "designer" terminal as well as the

claimed function of the designer terminal. Again, Applicant points out that a functional

limitation must be evaluated and considered, just like any other limitation of the claim, for what

it fairly conveys to a person of ordinary skill in the art. See MPEP §2173.05(g).

Further, claim 1 sets forth the feature of an account terminal for making a payment for

utilizing the design database from the bank account of the designer. Applicant respectfully

submits that Koritzinsky does not disclose an account terminal as claimed. That is, Koritzinsky

fails to disclose an account terminal which performs the function of making a payment from a

bank account of a designer. As explained above, functional limitations in a claim must be

afforded patentable weight.

Based on the foregoing, Applicant submits that claim 1 is patentable over the cited prior

art and respectfully requests that the Examiner reconsider and withdraw the rejection. Claims 2-

6 depend from claim 1 and therefore incorporate all of the features thereof. Accordingly,

Applicant submits that claims 2-6 are patentable at least by virtue of their dependency.

In addition, dependent claim 5 sets forth the feature of a means for the designer to

conduct circuit design for a device, and determine parts to employ through price simulation for

meeting a target price of the device and noise simulation for achieving a required noise proof

performance. The Examiner asserts that col. 6, lines 7-22 of Koritzinsky discloses such a

feature. Applicant respectfully disagrees.

In the passage cited by the Examiner, Koritzinsky merely discloses that communication

modules, workstation 72 and field service units 24 may be linked via a network configuration.

There is absolutely no mention of a means for the designer to conduct circuit design for a device,

and determine parts to employ through price simulation for meeting a target price of the device

and noise simulation for achieving a required noise proof performance. Accordingly, Applicant

requests that the rejection be reconsidered and withdrawn.

Independent claim 7 sets forth a network based design method having the features of a

parts vendor registering on a design database information on sample circuits; a designer

searching the design database and conducting the design of a device; and making a payment for

utilizing the design database from the bank account of the designer.

For similar reasons as discussed above with respect to claim 1, Applicant submits that

Koritzinsky fails to disclose or suggest the above mentioned method steps. Accordingly,

Applicant kindly requests that the Examiner reconsider and withdraw the rejection. Claims 8-12

depend from independent claim 7. Accordingly, Applicant submits that these claims are

patentable at least by virtue of their dependency. In addition, Applicant submits that claim 11 is

patentable for similar reasons as discussed above regarding claim 5.

Independent claim 13 sets forth a network based design serving system having a design

database server for storing a design database containing information on sample circuits and a

designer terminal for a designer to search the design database and conduct the design of the device.

For similar reasons as discussed above with respect to claim 1, Applicant submits that Koritzinsky fails to disclose or suggest the above mentioned features. Accordingly, Applicant kindly requests that the Examiner reconsider and withdraw the rejection. Claims 14-17 depend from independent claim 13. Accordingly, Applicant submits that these claims are patentable at least by virtue of their dependency. In addition, Applicant submits that claims 16 and 17 are patentable for similar reasons as discussed above regarding claim 5.

IV. New Claims

Claims 18-27 are added as new claims. Applicant submits that these claims patentably distinguish over the cited prior art based on the combination of features recited therein.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain

the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to

be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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WASHINGTON OFFICE
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